

## REMARKS

Claims 1-2, 4-53, and 55-63 are presently pending. Claims 3 and 54 have been canceled.

Independent claims 1 and 22, among other claims, were rejected under 35 U.S.C. § 102(b) as being anticipated by United States Patent No. 5,758,259 ("Lawler"). Assignee respectfully contends that Lawler does not explicitly or inherently anticipate the pending claims.

With regard to the anticipation rejections, MPEP 2131 states, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). MPEP 2131 also states, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Present claim 1 recites, among other features, that "the distribution unit is adapted to independently transmit on-demand a requested multimedia channel and an associated requested corresponding bandwidth to each of the plurality of STBs." Assignee respectfully maintains that Lawler does not disclose a requested corresponding bandwidth.

Present claim 1 contains language similar to canceled claim 3. In rejecting claim 3, Examiner cited a passage in Lawler relating to "video programming of substantially any duration ranging from individual image frames and brief video clips to full-length motion pictures." (Office Action, Page 3 (citing Lawler Col.10, lines 53-58)). Assignee contends that Lawler fails to disclose a bandwidth request simply by teaching that video programming of varying duration may be stored or transmitted. The server of Lawler is free to choose any bandwidth for storing or transmitting the programming, as opposed to responding to a bandwidth request. Indeed, Lawler makes no explicit reference to selecting bandwidth. For at least this reason, Assignee respectfully contends that independent claim 1 is allowable. Rejected claims 4, 8-10, 13, 18 and 20 depend directly or indirectly from allowable claim 1 and are thus similarly allowable.

Present claim 22 recites “a processor for processing and managing channel requests, bandwidth requests, and multimedia channel information.” As discussed above, Lawler does not disclose bandwidth requests. For at least this reason, Assignee respectfully contends that independent claim 22 is allowable. Claims 23-26, 29, 34 and 36 depend directly or indirectly from allowable claim 22 and are thus similarly allowable.

Claims 50, 59-60 and 62 depend directly or indirectly from independent claim 38, which was not rejected under 35 U.S.C. § 102(b) as being anticipated by Lawler. Assignee respectfully submits that rejection of these dependent claims under Lawler, without a commensurate rejection of claim 38, is improper and that claims 50, 59-60 and 62 are thus allowable.

Claims 5-7, 11-12, 14-17, 19 and 21, which depend directly or indirectly from claim 1, were rejected under 35 U.S.C. § 103(a) as being obvious over Lawler in view of various references. Assignee respectfully contends that none of these references cures the defects of Lawler regarding independent claim 1. For at least this reason, claims 5-7, 11-12, 14-17, 19 and 21 are allowable.

Claims 27-28, 30-33, 35 and 37 which depend directly or indirectly from claim 22, were rejected under 35 U.S.C. § 103(a) as being obvious over Lawler in view of various references. Assignee respectfully contends that none of these references cures the defects of Lawler regarding independent claim 22. For at least this reason, claims 27-28, 30-33, 35 and 37 are allowable.

Independent claim 38, among other claims, was rejected under 35 U.S.C. § 103(a) as being as being obvious over Lawler in view of U.S. Publication No. 2007/0157231 (“Eldering”). Assignee respectfully contends that Lawler and Eldering, taken alone or in combination, fail to teach all the elements of claim 38. Thus, there is no *prima facie* case for obviousness. Further, Assignee respectfully submits that Lawler and Eldering teach away from claim 38.

Claim 38 recites, among other features, “analyzing of subscriber viewing habits to determine whether the subscriber is channel surfing and storing subscriber channel surfing information.” In contrast, Lawler teaches that “station controller 20 transmits the viewer identifier only if the selected programming has been selected by the viewer or viewers for more than a minimum threshold amount of time.” (Lawler, Col. 7, lines 47-

50, (emphasis added)). Likewise, Eldering teaches that “the system is equipped with one or more filters that assist in determining selection data associated with irrelevant activities by the subscriber which should be excluded from the actual viewing selection data, e.g., selection data associated with channel surfing and/or channel jumping (up and down) activities by the subscriber.” (Eldering, Para [0009], (emphasis added)). Both Lawler and Eldering treat channel surfing information as unwanted or irrelevant. Neither reference teaches that channel surfing information is stored. Thus, the references fail to teach all the elements of claim 38. Further, by disclosing that channel surfing information should be ignored or discarded, the references teach away from claim 38.

For at least these reasons, Assignee respectfully contends that claim 38 is allowable. Claims 39-53 and 55-63 depend from allowable claim 38. Assignee respectfully contends that none of the other cited references cure the defects of Lawler and Eldering regarding independent claim 38. For at least this reason, claims 39-53 and 55-63 are allowable.

In general, the Office Action makes various statements regarding the claims and the cited references that are now moot in light of the above. Thus, Assignee will not address such statements at the present time. However, Assignee expressly reserves the right to challenge such statements in the future should the need arise (e.g., if such statements should become relevant by appearing in a rejection of any current or future claim).

For at least the foregoing reasons, the pending claims are in a condition for allowance. Examiner is requested to enter the amendments and pass this case to issuance.

The Commissioner is authorized to charge any additional necessary fees or credit any overpayment to the Deposit Account of McAndrews, Held & Malloy, Account No. 13-0017.

Respectfully submitted,

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Date: February 14, 2008

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